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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1821-01100

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Signature _____

Typed or printed name _____

Application Number

09/898,286

Filed

July 3, 2001

First Named Inventor

Geoffrey Donald Tremain

Art Unit

2136

Examiner

E. A. Shiferaw

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record. 42,771

Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

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Typed or printed name

713-238-8000

Telephone number

March 8, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of one (1) forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. :	09/898,286	Confirmation No.	2215
Applicant :	Geoffrey Donald Tremain	TC/AU :	2136
Filed :	July 3, 2001	Examiner :	Eleni A. Shiferaw
Title:	Method and Apparatus for Providing Computer Service	Customer No.:	23505

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA. 22313-1450

Atty. Dkt. No.: 1821-01100
Cl. Ref. No. AF/JG/P8015US
Date: March 8, 2007

Sir:

Appellant hereby submits this Pre-Appeal Brief Request for Review in connection with the above-identified application. A Notice of Appeal is filed concurrently herewith.

Appellant respectfully submits that the final office action dated November 13, 2006, fails to establish anticipation of the claims. In particular, the cited art fails to teach a virtual machine as taught in the application and recited in the claims. Respectfully, appellant requests that the reviewing committee withdraw all outstanding rejections and allow all pending claims in view of the comments and remarks below.

Claims 1-64 stand rejected under 35 USC § 102(e) as being anticipated by U.S. Patent App. Pub. No. 2001/0011304 ("Wesinger"), with reference to U.S. Pat. 6,434,594 ("Wesemann"), a Cisco News Release ("Cisco"), and a Seagate Software News Release ("Seagate") as extrinsic evidence of inherency and the state of the art.

In the advisory action of 2/6/2007, the examiner says "Examiner clearly stated that it is inherent for virtual hosts in the real server 100 [of Wesinger, US-A- 2001/0011304] to run different and/or separate operating system thereon BECAUSE they are virtual machines." (emphasis added). The examiner then says "For [the multiple virtual servers of Wesinger] VH 1-n

to be distinct, independent, and provide multiple different services to user, it is NECESSARY that the virtual hosts run separate OS.” (emphasis added) The examiner also refers to her earlier reference to Wesemann US-B- 6434594 as supporting her inherency argument. None of this is correct.

Wesinger explains at paragraph 0021 that a Web server is a software package or program that runs on a physical machine. Wesinger explains at paragraph 0022 that conventionally, the logical view of a Web server on the Web (i.e. how the Web server, which is implemented by the Web server software package, appears to or presents itself to the Web) is the same as the physical view of the underlying hardware, i.e. a single physical machine running a conventional Web server (program) appears as a single logical machine. Wesinger explains at paragraph 0023 that his Web server appears to the Web as multiple virtual hosts, even though his (one) Web server program is running on a single physical machine.

So, the first fallacy in the examiner's objection is that a Web server does not need ITS OWN operating system. It is correct to say that a Web server in the sense used by Wesinger is a computer program which runs on a computer and a computer needs an operating system, but the programs running on that computer do not (always) need to run their own operating system. For example, MS Word, IE Explorer, Outlook are all programs that run on a computer, but they do not need their own operating system: they are “just” software applications running on a computer. A Web server is the same in this respect.

Moreover, just as it is possible to run several instances of MS Word or IE Explorer on a single PC at the same time, Wesinger's Web server program effectively provides several (virtual) Web hosts operating on one physical machine. It is not correct to suggest that each of several instances of Word running on a single PC needs its own operating system: they are running on the same PC, which has its own operating system, but they do not have their own operating systems. Correspondingly, it is not correct to suggest that the several virtual Web hosts created by

Wesinger's Web server program each has or needs its own operating system. Wesinger's Web server program maintains the independence of the separate virtual Web hosts and nothing further is required.

Wesemann does not support the examiner's inherency argument. Referring for example to column 4, line 33 onwards, Wesemann discloses a type of "grid" or parallel computing system that allows computer programs or processes to be shared across several real computers by abstracting the application process into components that are referred to by Wesemann as "virtual processors". The passage at column 8, lines 9 to 40 of Wesemann cited by the examiner merely states that this is effected by using a memory-resident module that is platform-independent, so that, and this is the point here, the memory-resident module can be run on many different types of computer that run different operating systems such as MS Windows 95, 98, NT and Unix. Wesemann does not disclose (i) virtual hosts having operating systems running thereon (which is what the examiner should have said in the OA of 13th November 2006 when the examiner raised her inherency argument) or (ii) a computer node running different operating systems to provide virtual processing resources (which is what the examiner actually said).

It is to be understood that the single main point that needs to be conveyed is that neither Wesinger nor Wesemann, whether separately or together, discloses a "true" virtual machine, i.e. a virtual machine having an operating system running thereon, so that, in effect, it behaves like a real computer. Wesinger and Wesemann use words such as "virtual", "machine", "host", "operating system", separately and together, but never is there a disclosure of a "true" virtual machine, i.e. a virtual machine having an operating system running thereon, let alone the use of a (true) virtual machine as claimed in the independent claims of the present application.

With the foregoing understanding of the deficiencies of the cited art, we turn now to a specific discussion of the claims. Independent claim 1 recites "at least one virtual machine for each of said customers, said at least one virtual machine for each of said customers having a

specification specified by and configurable by the respective customer and having a separate operating system running thereon.” The examiner cites Wesinger’s virtual hosts as anticipating these limitations. To address Wesinger’s silence regarding operating systems, the examiner asserts that “it is inherent that the plurality of virtual hosts in the real server 100 runs different operating system because they are virtual hosts (see, evidence Wesemann ...)”. (Final Action p3ℓ15-18.)

As explained previously, Wesinger does not actually teach a virtual machine in the sense required by the claims of the present application. (*In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach in light of the specification.). See also 37 CFR 1.75(d)(1).) As explained for example in paragraphs 70 to 72 of the present specification, a virtual machine in the present context and as will be understood by those skilled in the art is a virtual construct that is created by special software and effectively exists only in the memory or other storage area of a real computer. A virtual machine acts as though it were a real computer but with the hardware components of the real computer “virtualised”. Thus, a virtual machine typically has a virtual CPU (central processor unit) on which an operating system runs, virtual memory, virtual storage, etc. Wesinger teaches only a daemon that forks off independent processes to handle connection requests. No virtual hardware components are created. For at least this reason, independent claim 1 and its dependent claims are allowable over the cited art.

Moreover, the examiner’s assertions of inherency are incorrect. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (*Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).) The examiner’s explanation that a virtual host has an operating system

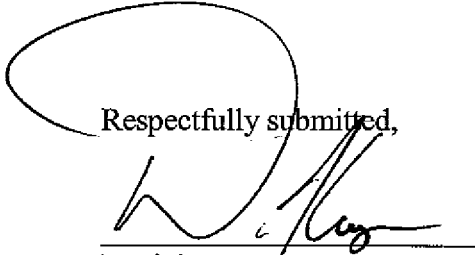
because it is a virtual host is circular, and does not establish that an operating system is necessarily present. The examiner's citation of Wesemann's teachings of a process that runs on multiple operating system platforms also fails to establish that the "virtual machine" of Wesinger is a virtual machine as required by the claims of the present application.

The point is, the independent claims of the present application are distinguished from Wesinger and Wesemann at least by the requirement of a "virtual machine". The reference in the claims of the present application to the virtual machine "having an operating system running thereon" is to ensure that it is understood that the virtual machines as presently claimed are "true" virtual machines, in the sense discussed at for example paragraphs 70 to 72 of the present specification.

Independent claims 20, 37, and 54 similarly recite a virtual machine having an operating system running thereon. As explained above, the cited art fails to teach this limitation. For at least these reasons, independent claims 20, 37, and 54, along with their dependent claims, are allowable over the cited art.

Should any fees have been inadvertently omitted, or if any additional fees are required, or if any fees have been overpaid, please appropriately charge or credit to those fees to Deposit Account No. 03-2769/1821-01100/HDJK of Conley Rose, P.C., Houston, Texas and consider this paper a petition for any necessary extension of time.

Respectfully submitted,



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